

REMARKS

Claims 1, 5 through 7, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37 through 42, 44 through 46, 48 through 53, 55 through 57, 59, 60 and 73 through 81 are pending in the application. Claims 76 through 81 are newly added.

On March 13, 2006, Applicants received a Notice on Non-Compliant Amendment (37 CFR 1.121), in the amendment filed on January 4, 2006. Applicants now re-submit a compliant amendment having proper status identifiers. Specifically, claims 76 through 81 have been labeled "new". The remarks of the amendment of January 4, 2006 are re-submitted for purposes of completeness. Reconsideration of this application is respectfully requested.

Claim 28 has been amended to correct a typographical error by adding a period at the end of the claim.

The Office Action rejects claims 73 through 75 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,448,685 to Ogura et al., hereafter Ogura.

This rejection is traversed. This rejection is erroneous because Ogura lacks a step or element recited in independent claims 73-75. Namely, Ogura lacks the step of "determining if a current job is an ad hoc job or a serial job", as recited in claims 73 through 75. The Examiner admits that Ogura does not use the terms "ad hoc job" and "serial job", but contends, based on the definition of the ad hoc job contained in Applicants' specification at page 8, lines 16-24, that one of ordinary skill in the art at the time the invention was [made] could interpret any job of Ogura as the disclosed and claimed AD HOC JOB". This contention is unfounded in law as 35 U.S.C. 102(b) does not refer to one of ordinary skill in the art. The Examiner has cited no authority for this view of the law permitting a test

of one of ordinary skill for interpretation of language for a rejection under 35 U.S.C. 102(b).

Moreover, Ogura contains no teaching of a mechanism or software that determines "if a current job is an ad hoc job or a serial job". Ogura discloses a label making machine with software that enables a user to specify or edit label size, layout position, identification codes (pertaining to standard sizes of labels and positions on the label sheet) and character sizes as noted at column 2, lines 11-15, and page 3, lines 5-9. None of these operations contains the claimed "determining" step.

To substantiate the reading of claims 73-75 on Ogura, the Examiner cites Ogura's Fig. 7 and column 7, lines 31-39, column 9, lines 32-60, and column 23, lines 17-24, as support for the rejection. Ogura's Fig. 7 depicts a view of a sheet of labels arranged in rows and columns and an insertion (or feed) direction. Column 7, lines 31-39, refers to a CPU 30 of Fig. 6 that "systematically controls a character input, character editing, selection of the type of label sheet, display operations and printing operations". Neither Fig. 7 nor this citation teaches "determining if a current job is an ad hoc job or a serial job" as claimed.

Ogura's column 9, lines 32-60, citation describes the operation sequence of CPU 30 of the flow chart shown in Figs. 8A and 8B, beginning with step 14. However, it is noted that the user has already powered up the machine and, from an initial screen of the options of "label formation" and "address book", has selected "label formation" at steps 8 and 12 as described in column 9, lines 23-27. There is no teaching that "label formation" and "address book" are an "ad hoc job" and a "serial job" as claimed.

Step 14 then gives the user the option of selecting selection menus of "new information" and "continuation". CPU 30 determines which selection menu is selected. If the continuation menu is selected, the contents of a previous work

are displayed so that the user can input a character (steps 18, 20 and 22). The continuation menu is not disclosed or taught as an ad hoc job or a serial job. Therefore, the step sequence of 14, 16, 18, 20 and 22 does not teach a determination of whether "a current job is an ad hoc job or a serial job" as claimed.

If new formation is selected at step 16, CPU 30 at step 24 presents a screen that designates a label sheet for designating a new character string. Steps 26 and 28 verify that the displayed label sheet is correct. Step 30 presents a character input screen. The new formation menu is not disclosed or taught as an ad hoc job or a serial job. Therefore, the step sequence of 14, 16, 24, 26, 28 and 30 does not teach a determination of whether "a current job is an ad hoc job or a serial job" as claimed.

Ogura's column 23, lines 17-24, citation merely addresses the printing of labels and does not disclose or teach any of the steps of independent claims 73-75.

Since Ogura lacks the determining step, Ogura also lacks the presenting steps, which are conditional on the determining step.

For the reason set forth above, it is submitted that the rejection of claims 73 through 75 under 35 U.S.C. 102(b) as anticipated by Ogura is erroneous and should be withdrawn.

The Office Action rejects claims 1, 5 through 7, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37, 39 through 42, 44 through 46, 48, 50 through 53, 55 through 57 and 59 under 35 U.S.C 103(a) as unpatentable over Ogura in view of U.S Patent No. 5,533,176 to Best et al., hereafter Best.

This rejection is erroneous. Claims 1, 5 through 7, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37, 39 through 42, 44 through 46, 48, 50 through 53, 55 through 57 and 59 are dependent on independent claims 73 through 75. As noted above in the discussion of independent claims 73 through 75, Ogura lacks the determining step. Best is not cited as supplying this deficiency and does not teach it. Therefore, this rejection is erroneous.

With respect to claims 28, 29, 33 through 35, 37, 39, 40, 44 through 46, 48, 50, 51, 55 through 57 and 59, the Examiner contends that Best discloses the ability of the user to assign positional palettes to the character positions as claimed by these claims. The Examiner substantiates this contention with the citation of Fig. 1 and column 4, line 41, through column 8, line 20. Applicants have been unable to find any substantiation in this citation or any other part of Best for the claimed assignment of positional palettes. It is noted that Best discloses the capability for the user to add or modify graphics. However, Best does not teach what the graphics are except for a logo at column 4, line 26. Clearly, Best does not teach that the graphics capability includes the ability to assign positional palettes as claimed.

With respect to claims 6, 7, 15 and 24, the Examiner admits that Ogura does not disclose the suppression of the printing of a bar code or at least one character position. The Examiner does not cite Best as teaching this feature, but contends that the feature would have been obvious to one of ordinary skill in the art without citing any supporting evidence. Without the citation of supporting evidence, the Examiner has not made a prima facie case for the rejection. Therefore, the rejection is erroneous.

With respect to claims 30, 31, 41, 42, 52 and 53, the Examiner contends that one of ordinary skill would have inherently recognized that the character to be printed could be a prefix or a suffix without citing any supporting evidence.

Without the citation of supporting evidence, the Examiner has not made a prima facie case for the rejection. Therefore, the rejection is erroneous.

There is no motivation for one of ordinary skill in the art to combine Ogura and Best. Ogura teaches a system that is useful for printing address labels, post cards, tack labels and cassette labels (to identify the items stored on the cassette). On the other hand, Best teaches a system for the design of bar code labels and the printing of the labels on various types of printers. There is no motivation for one skilled in the art to modify Ogura with the bar code teachings of Best so as to convert Ogura into a bar code printing system.

The Office Action suggestion to combine Ogura and Best is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 1, 5 through 7, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37, 39 through 42, 44 through 46, 48, 50 through 53, 55 through 57 and 59 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claims 38, 49 and 60 under 35 U.S.C 103(a) as unpatentable over Ogura in view of Best and further in view U.S. Patent No.

4,718,784 to Drisko, hereafter referred to as Drisko and U.S. Patent No. 5,621,864 to Benade et al., hereafter referred to as Benade.

This rejection is erroneous. Claims 38, 49 and 60 are dependent on independent claims 73 through 75 and on dependent claims 28, 39 and 50 as well. As noted above in the discussion of independent claims 73 through 75, Ogura lacks the determining step. Best is not cited as supplying this deficiency and does not teach it. Also, as noted above in the discussion of dependent claims 28, 39 and 50, neither Ogura nor Best discloses the assignment of positional palettes as claimed. Neither Drisko nor Benade supplies this deficiency. Therefore, this rejection is erroneous.

Moreover, the Examiner's contention that the combination of Ogura and Best would permit a user to designate a sequence of numbers on the labels and to save the last number in the sequence for future use when designing additional labels is erroneous. There is no teaching in either Ogura or Best for a user to enter a numerical sequence or of software that would enable it or respond to it as claimed. Furthermore, there is no teaching in Ogura or Best for the user to do another plurality of labels that continues with the next number in the sequence as claimed.

The Examiner contends in paragraph 6.2.2 that Drisko teaches a system that permits a user to enter information that would provide functionality as noted at items A, B, C and D. Contrary to the Examiner's contention, Drisko does not teach the functionality of items A, B and D. As to item A, Drisko merely selects a file of label designs from disk 28. Drisko contains no teaching for the user to enter or modify the alphanumeric content of any label. As to item B, Drisko teaches to modify attributes of the text as a whole, but not as to each character position. As to item D, Drisko's serial numbers are already on the labels retrieved from disk 28. Drisko contains no teaching for the user to enter or modify any serial number.

The Examiner is apparently citing Drisko as teaching the appearance of serial numbers on labels of a file. The Examiner concedes that Drisko does not teach saving the last serial number so that a subsequent plurality of labels could be printed continuing with the next serial number.

The Examiner contends that Benade teaches a system that permits a user to design one or more labels that are sequentially identified by an unique indicia. The Examiner further contends that one of ordinary skill in the art would inherently recognize that Benade's system would keep track of the last unique indicia used in a sequence so that the next indicia used would not be identical without the citation of supporting evidence. In fact, Benade's system automatically generates the sequence based on user input of the nature of the sequence and the start and end values. However, Benade does not teach saving the last value in the sequence. Therefore, Benade contains no teaching to support the Examiner's contention. Accordingly, the Examiner can make no prima facie case based on Benade.

There is no motivation to combine four different patents, Ogura, Best, Drisko and Benade as suggested by the Examiner. As noted above, there is no motivation to combine Ogura with Best. For similar reasons, there is no motivation to combine Ogura with either Drisko or Benade. That is, Ogura's system is radically different that those of Drisko and Benade.

The Office Action suggestion to combine four different patents, Ogura, Best, Drisko and Benade, is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the

inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 38, 49 and 60 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

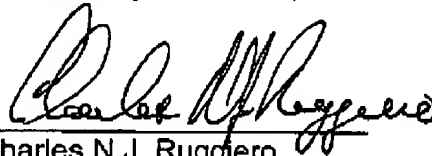
The Office Action cites U.S. Patent No. 5,615,123 to Davidson et al., hereafter Davidson, as noted at paragraph of the Office Action. Davidson has been reviewed, but is believed to be inapplicable to the claims.

Newly added claims 76, 78 and 80 recite that the variety of labels of the ad hoc job comprises at least one series of an ordered sequence of labels in addition to the some labels of the labels that are unrelated to other labels of the ad hoc job. Neither Ogura, Best, Drisko or Benade disclose or teach such an ad hoc job alone or in combination with a serial job. Newly added claims 77, 79 and 81 recite that the sequential fashion of the serial job is a predetermined ordered sequence. Ogura, Best, Drisko and Benade do not teach the combination of the serial job and an ad hoc job.

For the reasons set forth above that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 1, 5 through 7, 10, 14, 15, 19, 23, 24, 28 through 31, 33 through 35, 37 through 42, 44 through 46, 48 through 53, 55 through 57, 59, 60 and 73 through 81 be allowed and that this application be passed to issue.

Respectfully Submitted,

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Charles N.J. Ruggiero
Reg. No. 28,468
Attorney for Applicants
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.
One Landmark Square, 10th Floor
Stamford, CT 06901-2682
(203) 327-4500